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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/087,942

03/05/2002

Robert L. Campbell

41552

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08/11/2004

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EXAMINER

MARSCHER, ARDIN H

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,942

Applicant(s)

CAMPBELL ET AL.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-127 is/are pending in the application.
- 4a) Of the above claim(s) 16,17 and 31-127 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-30 is/are rejected.
- 7) ☒ Claim(s) 3, 5, and 8-10 is/are objected to.
- 8) ☒ Claim(s) 1-127 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/5/02.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Applicant's election with traverse of Group I (claims 1-15 and 18-30) in the Paper, filed 1/22/04, and four specie elections, without traverse, in the Paper, filed 5/20/04, is acknowledged. The traversal is on the ground(s) that Groups I, IV, and VIII recite the same basic steps which define the same essential characteristics of a single disclosed embodiment of the invention and note the withdrawal of a similar requirement in parent application serial number 09/359,260. This is not found persuasive because applicants' traversal arguments have not been directed to the summarized differences and distinctnesses between Groups I, IV, and VIII as set forth in the Office action, mailed 10/20/03, on pages 3-5. Thus, the traversal arguments are not directed to the bases for the restriction requirement and thus non-persuasive.

The requirement is still deemed proper and is therefore made FINAL.

Upon reconsideration, all of the specie election requirements regarding the invention of Group I is hereby withdrawn.

SEQUENCE RULE NON-COMPLIANCE

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR §§1.821(a)(1) and (a)(2). See, for example, the sequences in the specification on page 45, line 11, which do not have SEQ ID Nos therewith. However, this application fails to comply with the requirements of 37 CFR §§ 1.821 through 1.825 because it lacks the above noted sequences in a computer readable form sequence listing, a paper copy for the specification, a statements under 37 CFR

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§§ 1.821(f) and (g), and SEQ ID Nos cited along with each sequence in the specification. Applicants are also reminded that a CD-ROM sequence listing submission may replace the paper and computer readable form sequence listing copies. Applicant(s) are given the same response time regarding this failure to comply as that set forth to respond to this office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

NON-STATUTORY SUBJECT MATTER

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 and 18-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Consideration of the "Computer-Related Inventions" section of the MPEP at section 2106, Part IV, subpart B, has revealed that the instant claims are directed to non-statutory subject matter without requiring performance of a result outside of a computer. Thus, the manipulation of data or conversion of data, in this case determining a relationship from a first test library and then identifying a second test library is the claimed subject matter without any physical transformation outside of a computer. It is noted that instant claim 1 cites the measuring of a first indicia which is deemed a data manipulation steps as a property is not cited as being measured but rather a manner of measuring as an indicia which is deemed a computer step as its general embodiment which

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performs determination and identification without any requirements for physical action or movement cited in the claims. No tangible physical transformation steps are apparent in the above listed instant claims.

VAGUENESS AND INDEFINITENESS

Claims 1-15 and 18-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the "measuring first indicia" is further determined in lines 6-8 but without connection or definition of cooperativity between measured first indicia in order to define either the "relationship" in claim 1. Thus, the metes and bounds of the determining of said "relationship" is undefined as claimed and therefore vague and indefinite as to what is meant. Clarification via clearer claim wording is requested. This vagueness and indefiniteness also is present in claims directly or indirectly dependent from any of these claims via their dependence.

INFORMALITIES

The disclosure is objected to because of the following informalities:

The parameters wherein subscripts are present are printed with too small of a font to read them clearly. Claims 3, 5, and 8-10 are hereby required to be submitted with larger font for readability.

Appropriate correction is required.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform

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with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 7, 2004

Ardin H. Marschel 8/7/04
ARDIN H. MARSCHEL
PRIMARY EXAMINER